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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Soho Corporation

Serial No. 75/391,891

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Ltd. for Soho Corporation.

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Before Cissel, Seeherman and Bottorff, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Soho Corporation has appealed from the final refusal of the Trademark Examining Attorney to register HOLD EVERYTHING! as a trademark for "plastic storage boxes for household use."¹ Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the following

¹ Application Serial No. 75/391,891, filed November 18, 1997, and asserting first use and first use in commerce in March 1987.

three registrations, all owned by Williams-Sonoma, Inc., that, as used on applicant's goods, it is likely to cause confusion or mistake or to deceive:

Mark	Services
HOLD EVERYTHING	Retail store services in the field of containers and storage devices ²
	Distributorship and retail store services in the field of containers and storage devices ³
	Retail store and mail order catalog services in the field of containers and storage devices ⁴

² Registration No. 1,448,980, issued July 21, 1987; Section 8 affidavit accepted; Section 15 affidavit received.

³ Registration No. 1,433,336, issued March 17, 1987; Section 8 affidavit accepted; Section 15 affidavit received.

⁴ Registration No. 1,743,760, issued December 29, 1992; Section 8 affidavit accepted; Section 15 affidavit received. The drawing is lined for the color red, but color is not claimed as part of the mark. The registrant is identified in this registration as Williams-Sonoma, Inc., d/b/a Hold Everything Corporation.

The appeal has been fully briefed, but an oral hearing was not requested.

We affirm the refusal with respect to all three of the cited registrations.

Before turning to the substantive issue before us, we note that applicant has raised objections to materials submitted by the Examining Attorney with his brief. Applicant is correct that, as provided by Trademark Rule 2.142(d), the record in the application should be complete prior to the filing of an appeal. Accordingly, the Internet materials and third-party registrations will be given no consideration. Applicant has also objected to the unpublished cases cited by the Examining Attorney in his brief. Again, applicant's objection is well taken. The fact that the Board stamped these decisions, "This disposition is not citable as precedent of the T.T.A.B." means just that. We have not considered these decisions in rendering our decision.

In determining whether there is a likelihood of confusion between two marks, we must consider all relevant factors as set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis under Section 2(d), two of

the most important considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The marks are identical in pronunciation and connotation, and virtually identical in appearance. The minimal background design elements in two of the cited marks, and the exclamation point in applicant's mark, do not serve to distinguish them. The commercial impressions of applicant's mark and the registered marks are the same.

Applicant's goods and the registrant's services are closely related. Applicant's goods are plastic storage cases, and registrant's retail store, distributorship and mail order catalog services all feature containers and storage devices. Thus, registrant offers for sale the very types of goods produced by applicant. Although the respective identifications are sufficient to demonstrate the relationship between applicant's goods and registrant's services, the Examining Attorney has also made of record third-party registrations which further support the relatedness of the goods and services.⁵ Third-party

⁵ See, for example, Registration No. 2,212,237 for, inter alia, all-purpose containers for household or kitchen use, and

registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993). In this case, the third-party registrations serve to suggest that parties use their marks for both retail store and mail order catalog services and for the goods which are sold via those services.

In view of the nature of the goods and services, and because there are no restrictions in the identifications, we must assume that they are offered to the public at large, rather than to a sophisticated segment of that public.

Applicant itself has conceded that the marks are similar and the goods and services are related. Brief, p. 2. However, applicant asserts that confusion is not likely because the registered marks are entitled to a limited scope of protection, and because there have been no instances of actual confusion.

With respect to the first point, applicant argues that the cited marks "are highly suggestive, if not descriptive,

retail/wholesale mail order catalog services featuring all-purpose containers for household or kitchen use.

of the services offered under the marks." Brief, p. 3. We find this argument to be somewhat surprising, not only because a claim that a registered mark is descriptive would be an impermissible collateral attack on a registration,⁶ but because if the cited marks were to be considered merely descriptive, applicant's mark would also suffer from the same infirmity. However, not only are the cited marks not merely descriptive, we do not consider them to be suggestive. This is because, in addition to informing consumers that the goods registrant sells hold a variety of things, the marks also have the meaning of "Stop" or "Wait a minute." This double entendre gives the cited marks a catchy and memorable quality, such that they fall much more on the arbitrary side of the arbitrary-generic continuum than on the suggestive side. Moreover, even if we were to consider the registrant's HOLD EVERYTHING marks to be suggestive, the suggestive connotation would be the same as that of the applicant's mark. Suggestive marks are entitled to protection against likelihood of confusion, and given the related nature of the goods and services, even if

⁶ If an applicant wished to claim that a mark cited against it were merely descriptive, it would have to do so by way of a cancellation action. Applicant herein could not bring such a proceeding in the instant situation, however, because the cited registrations are all more than five years old, and therefore the ground of mere descriptiveness cannot be asserted against them.

we were to accord the registered marks a more limited scope of protection, it would still be broad enough to bar applicant's registering the virtually identical mark for closely related goods.

We find applicant's second argument, that there have been no instances of actual confusion, to be similarly unpersuasive. Applicant asserts that it has used its mark since 1987, and that the cited registration for HOLD EVERYTHING in the somewhat rectangular line border claims a first use date of 1983. (The registration for HOLD EVERYTHING per se claims a first use date of 1985, and the registration for HOLD EVERYTHING with the red background design claims a first use date of 1991.) Applicant argues that there have been thirteen years of concurrent use of the marks, and this is strong evidence that confusion is not likely to occur in the future.

There are several problems with this argument, the most notable being that, in this ex parte proceeding, we have had no opportunity to hear from the registrant as to whether it has encountered any instances of confusion. The various cases cited by applicant are thus distinguishable, because they involve inter partes proceedings.

Applicant did cite one ex parte case, **In re General Motors Corp.**, 23 USPQ2d 1465, 1470-71 (TTAB 1992), in which

the Board gave weight to the fact that applicant had experienced no confusion in reaching the conclusion that confusion was not likely between applicant's use of GRAND PRIX for automobiles and the cited registrations for GRAND PRIX and design marks for automotive replacement parts. However, the Board specifically stated in that case that the circumstances were very unusual:

We recognize, of course, that the above is one-sided inasmuch it provides only applicant's experience in the marketplace and not that of registrant. Normally, in the absence of a detailed consent agreement, the registrant has no opportunity to be heard in an *ex parte* proceeding of this type and the Board, therefore, is not in a position to meaningfully assess whether the claimed period of contemporaneous use has provided ample opportunity for confusion to have arisen. See, e.g., *In re Jeep Corp.*, *supra* [222 USPQ 333 (TTAB 1984)] at 337. The asserted absence of actual confusion, especially over a relatively short period of years, has thus often been asserted to be of "limited influence" or of "dubious probative value". See, e.g., *In re Barbizon International, Inc.*, 217 USPQ 735, 737 (TTAB 1983) and *In re Whittaker Corp.*, 200 USPQ 54, 56 (TTAB 1978), respectively.

In the present case, however, we have a confluence of facts which persuasively point to confusion as being unlikely. Specifically, during a nearly thirty-year interval of sustained success in the marketing of what, for the average consumer, is typically a major and expensive purchase, applicant has

experienced no reported instances of actual confusion between its use of "GRAND PRIX" in connection with almost 2.7 million automobiles and registrant's use of its "GRAND PRIX" marks for related automotive replacement parts.

In this case, applicant has provided no information whatsoever about its sales activities, such that we can say it has experienced an extended interval of "sustained success."⁷ Further, the plastic storage cases applicant sells cannot be considered "a "major and expensive purchase,"⁸ such that if any purchasers were confused by the mark, they are likely to have contacted applicant to report

⁷ In its reply brief applicant asserts that the Examining Attorney raised for the first time in his brief that there is no evidence as to the extent of the use of the applicant's and registrant's marks. Applicant states that if this issue had been raised during examination, it would have submitted evidence to demonstrate that there was an opportunity for confusion to occur, and at the very least the application should be remanded to the Examining Attorney so that applicant can supplement the record. Applicant's request for remand is denied. The Examining Attorney did not raise a new issue in his brief, merely a new argument with respect to the factor of "the length of time during and conditions under which there has been concurrent use without evidence of actual confusion." **In re E.I. du Pont de Nemours & Co.**, supra, 177 USPQ at 567. Since applicant was asserting that this factor favored its position, applicant should have submitted any evidence in support of it during the course of prosecution. Moreover, applicant was obviously aware of the evidence which was found to be probative in the General Motors case, since it was applicant that relied on this case not only in its brief but in the responses it filed during the prosecution of the application.

⁸ Although we have given no consideration to the Internet evidence submitted by the Examining Attorney with his brief that indicates the price at which plastic storage boxes are sold, we may take judicial notice that plastic storage boxes are relatively inexpensive items.

their confusion.⁹ Thus, the General Motors case is not applicable to the present situation. Rather, we think it appropriate to follow the general rule that, in an ex parte situation, the fact that the applicant has not experienced any instances of actual confusion is entitled to limited weight.

Accordingly, although we have considered such evidence in reaching our decision herein, upon review of all of the relevant factors, and particularly the virtual identity of the marks and the closely related nature of the goods and services, the commonality of purchasers and the inexpensive nature of the purchase, we find that applicant's mark HOLD EVERYTHING! for plastic storage boxes for household use is likely to cause confusion with the three registered marks.

Decision: The refusal of registration is affirmed.

⁹ In fact, it seems to us more likely that a dissatisfied consumer would go to one of the registrant's retail stores to make a complaint about a problem with a plastic storage case. Similarly, if a consumer wished to purchase a HOLD EVERYTHING! plastic storage case, such an inquiry is more likely to be made to a HOLD EVERYTHING store than to the Soho Corporation.